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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,427	07/09/2001	Kevin James Curie	24180-124004	8562

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Matthew E. Leno
McDermott, Will & Emery
31st Floor
227 West Monroe Street
Chicago, IL 60606

EXAMINER

DYE, RENA

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,427

Applicant(s)

CURIE ET AL.

Examiner

Rena L. Dye

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Mh

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/15/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-19,21-35,37-51,53-67,69-84 and 86-153 is/are pending in the application.
- 4a) Of the above claim(s) 99-126 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-19,21-35,37-51,53-67,69-84,86-98 and 127-153 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>#13,14</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 12/15/03 has been entered.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on July 14, 2003 and January 22, 2004, filed on or after the mailing date of the Request for Continued Examination and prior to the first action on the merits have been considered. The submission is in compliance with the provisions of 37 CFR 1.97.

Specification

3. The use of the trademarks/names Morton EFM-2E02 (Examples 1 & 3), and Mitsui Admer QB510A (Example 10) has been noted in this application. It is noted that these specific trade names are not defined. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

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The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931). See MPEP § 608.01(v)

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 17,21-25,27,30-33,37-41,43,44,46-49,53-57,59-60,62-65,69-73,75,76,78-82,86-90,92,93,95-98,127,129-141, and 143-153 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant only discloses maleic anhydride as the “adhesive” Therefore, one having ordinary skill in the art would not have known what other materials could be used in Applicant’s invention as an “adhesive” for bonding layers. Although the specification discloses at page 8, first paragraph, that “an appropriate adhesive is chosen dependent

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upon the material of the middle layer 26 to bond the inner and outer layers 24,28 thereto”, however, it is noted that Applicant is only disclosing and claiming layers of polypropylene and EVOH/nylon specifically, which are bonded using an adhesive, the adhesive more specifically being maleic anhydride (page 14, first embodiment). Therefore, Applicant has not clearly enabled the bonding of polypropylene and EVOH/nylon with anything other than maleic anhydride, thus, the present claims should be limited accordingly.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 65-67 and 69-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 65, lines 5-7, the phrase “the first layer not having an adhesive-free layer directly adjacent thereto other than the first layer” is unclear and confusing. Clarification is requested.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-3,5-19,21-35,37-51,53-67,69-84,86-98 and 127-153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilpers et al. (H1419).

Wilpers et al. teaches that it is an object of his invention to provide polymeric compositions having and exhibiting improved bonding to other incompatible polymeric materials, particularly to polar materials. It is a further object to provide a simple and economical method of bonding incompatible polymeric materials, but further providing a polymeric composition comprising functionalized high melt flow polyolefin (adhesive) and unfunctionalized polyolefin. This composition exhibits improved adhesion to polar materials. Functionalization is accomplished by reacting with a carboxylic acid anhydride, which can be exemplified by maleic anhydride, and is the preferred functional group (column 1, lines 39-55; column 2, lines 47-51). Example 1 illustrates a composition including an unmodified polypropylene with a modified polybutylene (Example 1). The compounds have numerous uses in producing films, molded parts cups, trays and containers. Improved adhesion is exhibited, especially towards polar substrates, such as EVOH copolymer and polyamides (nylons) (column 2, lines 52-59).

Although Wilpers does not specifically teach the claimed amount of maleic anhydride, it would have been obvious to one having ordinary skill in the art to have varied the amount of maleic anhydride grafted to the polybutylene to have provided varying degrees of adhesion to the polar substrates. Therefore, the amount of maleic anhydride (about 0.01 to about 0.20 percent by weight) would have been known or easily determined by one having ordinary skill in the art since it provides the function of adhering a polypropylene to an EVOH or nylon layer, as does Applicant's claimed invention.

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Since Wilpers et al. specifically teaches containers, and it is well known in the art to biaxially stretch containers during the molding process to provide strength, it would have been obvious to one having ordinary skill in the art to have biaxially stretched the container taught by Wilpers et al.

Since Applicant's claimed invention is met by Wilpers et al., it is the Examiner's position that the recited haze value would have been within the scope of the reference, or obvious to one having ordinary skill in the art to have achieved the haze value based upon the teaching of the reference.

As broadly as the invention is recited, the claims would include the blend taught by Wilpers et al. which includes an unmodified polypropylene with a modified polybutylene directly bonded to the EVOH/nylon layer.

Response to Arguments

8. Applicant's arguments filed on December 15, 2003 regarding the restriction requirement has been considered. In view of Applicant's arguments, claims 127-153 have been examined along with the elected product claims; however, in view of the numerous inventions/embodiments, the examiner has maintained the restriction requirement.

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Where product and process claims drawn to independent and distinct inventions presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. See MPEP § 821.04.

9. Applicant's arguments filed on December 15, 2003 and April 11, 2003 have been fully considered but they are not persuasive. It is the Examiner's position that Wilpers et al. continues to meet the claimed invention. Wilpers et al. specifically teach a polymer composition exhibiting improved bonding comprising a functionalized polyolefin and unfunctionalized polyolefin, which is further used to make containers. Suitable functional groups containing compounds refer to polar groups which include but are not limited to anhydrides, carboxylates, and acrylates, the preferred group being maleic anhydride. Containers are formed therefrom.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rena L. Dye whose telephone number is 703-308-4331. The examiner can normally be reached on Monday-Tuesday 8:30 AM - 5:00 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Rena L. Dye', with a stylized flourish at the end.

Rena L. Dye
Primary Examiner
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R. Dye
March 3, 2003